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SUPREME COURT, U. S

No. 73-1041

In the

Supreme Court of the United States

OCTOBER TERM, 1973

PHILLIPS PETROLEUM COMPANY,

Petitioner,

vs.

KARL ZIEGLER,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

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Phillips Petroleum Company petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Fifth Circuit entered on April 13, 1973.

OPINIONS BELOW

The opinions of the Court of Appeals and the District Court are not yet officially reported. They appear respectively in the Appendix, at pages 2a and 36a. The order denying rehearing appears in the Appendix at p. 1a.

JURISDICTION

The judgment of the Court of Appeals was entered on April 13, 1973. The Court of Appeals order denying petitioner's timely petition for rehearing was entered on August 3, 1973. This petition was filed within 90 days thereafter. The jurisdiction of this Court is invoked under 28 U.S.C. §1254(1).

STATUTE INVOLVED

The relevant portion of the Patent Code is 35 U.S.C. §112 which is set forth in the Appendix at p. 49a.

QUESTION PRESENTED FOR REVIEW

The Patent Office, in executing its statutory duty of ensuring that issued patents clearly define the scope of the patent monopoly, has adopted a uniform vocabulary of expressions for setting the scope of patent claims. The question presented on this petition is whether the federal courts in infringement litigation may properly disregard the restrictive meanings of the Patent Office terms of art and redefine the claim terminology so as to enlarge the scope of the patent monopoly granted.

STATEMENT OF THE CASE

This is a civil action for infringement of two patents, 3,257,332 ('332 patent) and 3,113,115 ('115 patent), brought by the patent owner, Karl Ziegler, against the petitioner, Phillips Petroleum Company. Both patents claim certain chemical catalysts which are used to produce plastics. This petition concerns only the '115 patent.

Claim 1 of the '115 patent, includes in its preamble the widely used expression of patent drafting, "essentially consisting of."[1] Thus, the claim is in the form, "Polymerization catalyst essentially consisting of . . . [A and B]" where A and B are two catalyst components. The expression "essentially consisting of" is part of a Patent Office code of vocabulary and is used to restrict patent claims to the recited components and to exclude everything except "unspecified ingredients which do not materially affect the basic and novel characteristics of the composition." (App. 51a) The expression was inserted by Ziegler in order to overcome a rejection on the grounds that the original claim was too broad. (App. 30a)

The accused Phillips catalyst has three components, A, B, and C. (App. 27a) The District Court found that Phillips' three component catalyst did not "essentially consist of" two components as claimed and consequently did not infringe the claim.

The Court of Appeals for the Fifth Circuit reversed, concluding that Phillips' three component catalyst was embraced by Ziegler's claim. Viewing the question of claim construction as one of law (App. 11a) and consequently not within the restrictions of Rule 52(a),

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[1] Claim 1 of '115 appears at note 3 of the Court of Appeals decision at p. 8a below.

F. R. Civ. P., the Court of Appeals rejected the Patent Office's restrictive definition of the expression "essentially consisting of" as "beyond reasonableness." (App. 31a) The Court broadly construed the expression to leave the claim open for any other components so long as the two recited components are "necessarily present." (App. 31a)

Phillips' timely petition for a rehearing was refused on August 3, 1973. (App. 1a)

For reasons discussed below, Phillips asks this Court to review the matter on writ of certiorari.

REASONS FOR GRANTING THE WRIT

Introduction

The question raised is of major importance because the decision below, in dealing with the expression "essentially consisting of", effectively abrogates the restrictive construction intended by the U. S. Patent Office in issuing patent claims containing these words.

The Court should grant certiorari for two reasons: (1) The decision interferes with the proper discharge by the Patent Office of its responsibility to inform the public of the outer limits of a patent monopoly. As the only Court of Appeals decision expressly dealing with this expression, the decision effectively shatters the integrity of the current clearly understood code of language used by Patent Office practitioners and by the Patent Office to restrict the scope of patent claims. Consequently, the Patent Office cannot assure the public that the patents it issues will "distinctly claim" the metes and bounds of the patent monopoly as required by 35 U.S.C. §112; (2) The decision renders thousands of extant patents using the restrictive code terminology broader now than when they were granted.

REASON I

THE COURT SHOULD APPROVE THE EXISTING PATENT OFFICE PRACTICE

The Patent Office Functions To Eliminate Unpatentable Material

"The primary responsibility for sifting out unpatentable material lies in the Patent Office," *Graham* v. *John Deere*, 383 U.S. 1, 18 (1966). There is only one way, under the present statutory scheme, by which the Patent Office can execute this function—by using language as a tool to mold claims which restrict the monopoly to the patentable invention disclosed in the application and exclude what is unpatentable. For this very reason, the Patent Act requires the applicant to conclude his application "with one or more claims particularly pointing out and distinctly claiming . . . his invention." (35 U.S.C. §112 App. 49a) Of the same requirement in an earlier Patent Act, this Court said in *McClain* v. *Ortmayer*, 141 U.S. 419 (1891) at page 424:

> "The object of the patent law in requiring the patentee to 'particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery,' is not only to secure to him all to which he is entitled, but *to apprise the public of what is still open to them. The claim is the measure of his right to relief*, and while the specification may be referred to to limit the claim, it can never be made available to expand it." [Emphasis added.]

(See also *U.S.* v. *Adams*, 383 U.S. 39, 49 (1966).)

The Courts, with the benefit of adversary proceedings, may or may not agree with the Office's conclusion that the subject matter meets the requisite standards of patentability. But, while the Courts, in infringement suits,

may disagree with the Patent Office on the question of patentability, there should be no disagreement on the meanings of restricting expressions used to limit the scope of issued claims. The Courts should not expand the meanings of such expressions to put back into the claims what the Patent Office has "sifted out"; to do so is a direct interference with the Office's "primary responsibility." Thus, *in Burns* v. *Meyer*, 100 U.S. 671 (1880) this Court said at page 672:

> "it is well known that the terms of the claim in letters-patent are carefully scrutinized in the Patent Office. Over this part of the specification the chief contest generally arises. It defines what the office, after a full examination of previous inventions and the state of the art, determines the applicant is entitled to. The courts, therefore, should be careful not to enlarge, by construction, the claim which the Patent Office has admitted, and which the patentee has acquiesced in, beyond the fair interpretation of its terms."

Similary in *Keystone Bridge Co.* v. *Phoenix Iron Co.*, 95 U.S. 274 (1877), this Court said at page 278:

> "[T]he courts have no right to enlarge a patent beyond the scope of its claim as allowed by the Patent Office, or the appellate tribunal to which contested applications are referred. When the terms of a claim in a patent are clear and distinct, (as they always should be) the patentee, in a suit brought upon the patent, is bound by it . . . . He can claim nothing beyond it."

The Patent Office Necessarily Uses a Special Vocabulary To Restrict the Scope of Patent Claims

In carrying out its "sifting" function, and in requiring patent applicants to "particularly point out and distinctly

claim" their inventions, the Patent Office relies heavily on a code of various terms of art in patent claims. Until the decision below, both patent practitioners and the Courts have uniformly understood this code or vocabulary of restrictive phrases. The code was described by the Board of Appeals in *Ex parte Davis*, 80 USPQ 448, 450 (P.O. Bd. App. 1948), as follows: (App. 57a)

> "It has come to our attention that a group of the Primary Examiners of the Patent Office, for their own guidance, adopted a code of terms for use in compositions to aid uniformity of practice, which regarded:—
>
> (1) 'comprising' and 'comprising essentially' as leaving the claim open for the inclusion of unspecified ingredients even in major amounts;
>
> (2) 'consisting of' as closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith, and
>
> (3) recital of '*essentially*' along with 'consisting of' as rendering the claim *open only for the inclusion of unspecified ingredients which do not materially affect the basic and novel characteristics of the composition.*" (Emphasis added)

The full decision appears in the Appendix at p. 52a, together with a certification by the Acting Solicitor of the U.S. Patent Office showing that it is emphasized in the current lecture outline of the curriculum of the Patent Office Academy for the examining corps of the Patent Office as authority on open and closed language used to regulate the breadth of patent claims. (App. 50a)

These definitions have been accepted in virtually every tribunal where the phrases have been considered. The particular expression involved here, "essentially consisting of", or the equivalent expression "consisting essentially

of", has been considered and the definition set forth in ***Ex parte Davis*** has been adopted in the Patent Office,[2] in the Court of Customs and Patent Appeals[3] and in various District Courts.[4] Similarly, virtually every text-book dealing with the terminology restates the *Ex parte Davis* definitions.[5]

When the expression was considered outside the Patent Office tribunals in *American Mach. & Fdry. Co.* v. *Liggett & Myers Tobacco Co.*, 172 F.Supp. 12 (D. N. J. 1959); aff'd. 272 F.2d 451 (3 Cir. 1959), the Court said at page 19:

> "The Patent Office Board of Appeals has defined certain terms of art, commonly employed in patent applications . . . . '[C]onsisting essentially of' the words with which we are concerned, renders 'the claim open only for the inclusion of unspecified ingredients which do not materially affect the basic and novel characteristics of the composition.' Thus, if any of the undisclosed additives materially affect the basic and novel characteristics of the MTS made from

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[2] *Ex parte Davis*, 80 USPQ 448 (P.O. Bd. App. 1948); *Ex parte Hutchins*, 157 USPQ 167 (P. O. Bd. App. 1967).

[3] *In re Sutton et al.*, 211 F.2d 582 (CCPA 1954); *In re Janakirama-Roa*, 317 F.2d 951 (CCPA 1963); *In re Garnero*, 412 F.2d 276 (CCPA 1969).

[4] *American Mach. & Fdry. Co.* v. *Liggett & Myers Tobacco Co.*, 172 F.Supp. 12 (D. N.J. 1959); aff'd 272 F.2d 451 (3 Cir. 1959); *C. O. Jelliff Mfg. Corp.* v. *Watson*, 187 F.Supp. 232 (D. D.C. 1960); *Intermountain Research Co. Inc.* v. *Hercules Inc.*, 163 USPQ 390 (C.D. Cal. 1969).

[5] *Patent Claim Drafting* (2nd Ed.) 1952, Dacot Publications, Kerrville, Texas, pp. 410-415; 3 Deller's *Patent Claims* (2nd Ed.) 1971, pp. 110, 131; *The Encyclopedia of Patent Practices & Invention Management*, 1964, Reinhold Publishing Co., p. 151; *Glossary of U.S. Patent Practice*, 1969, Sage Hill Publishers, p. 22; *Law of Chemical, Metallurgical and Pharmaceutical Patents*, 1967, Howard I. Forman, Central Book Co., N.Y., p. 758.

> all runs except the ferrotype, Dr. Bandel's composition is not within the teaching of the counts, at least as to those runs."

The Fifth Circuit's decision here is the *only* Court of Appeals decision dealing with the meaning of the terms and is the highest authority on this point of law. Furthermore, this decision is the only one which has abandoned the heretofore accepted definition of the restrictive terms "essentially consisting of." Consequently, the decision casts serious doubt on the earlier, uniform body of law and eliminates the certainty previously connected with the use of the terms which the Patent Office has consistently relied upon in setting the scope of claims.

The Fifth Circuit Redefined the Expression As Open Ended

Phillips, in supporting the finding of non-infringement, relied upon the uniform restrictive meaning of "essentially consisting of" as expressed in *Ex parte Davis*, (App. 31a). The Court of Appeals, however, said that, "Phillips' contention stretches . . . the quoted language beyond reasonableness" (App. 31a) thereby rejecting the intended meaning of the Patent Office.

Instead of accepting the Patent Office meaning, the Court redefined the expression as follows:

> "[T]he most logical and persuasive construction of the phrase would be to read it as limiting the '115 catalyst to one in which both elements are necessarily present." (App. 31a)

This new definition is virtually the same as that given the broad term "comprising", also defined as part of the code in *Ex parte Davis*. (App. 57a). (See also *Parmelee*

Pharmaceutical Co. v. *Zink*, 285 F.2d 465, 469 (8 Cir. 1961). To define the invention only in terms of what is "necessarily" present is precisely the purpose and meaning of the term "comprising". While the Court of Appeals definition purports to limit the claim to a composition of matter where the recited elements are "necessarily" present (App. 31a), the term "necessarily" clearly places no limitation at all on additional ingredients, and the claim is consequently "open for the inclusion of unspecified ingredients even in major amounts." The Court of Appeals has thus blurred the distinction between the two standard and accepted expressions "comprising" and "consisting essentially of" and in so doing has wholly abrogated the precision of restrictive vocabulary used in the Patent Office to provide uniformity of practice.

REASON II

The Decision Effectively Enlarges the Scope of Thousands of Extant Patents

There are on the order of 75,000 extant patents covering new compositions of matter. Of these, petitioners estimate[6] that about 15,000 contain claims using the language "consisting essentially of" or the equivalent "essentially consisting of." Until the Fifth Circuit's decision here, the public, and particularly patent practitioners who deal with these patents on a day-to-day basis, have understood the meaning of the restrictive ex-

[6] The figures of 75,000 and 15,000 are only conservative approximations. They are based on a study of the patents issued during the seven week period embracing the '115 patent. Percentage figures were calculated for those patents on new compositions of matter and those using the expressions "consisting essentially of" or "essentially consisting of." These percentage figures were then applied to the total number of extant patents.

pression. These patents were all issued subsequent to the adoption of the code in *Ex parte Davis* (App. 52a). Consequently, the 15,000 patents using the "essentially consisting of" expression were considered appropriately limited when they were issued. With the Fifth Circuit's decision, which we again note is the only Court of Appeals decision dealing with the expression, the scope of each of these patents is effectively enlarged beyond the Patent Office's original grant. The result will undoubtedly be a flood of litigation to determine the new boundaries of the affected patents.

CONCLUSION

For these reasons, the Court should grant the petition.

Respectfully submitted,

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